

REMARKS

Introductory remarks

The present letter is filed in response to the Examiner's Final Action of November 4, 2008. Currently pending claims 1, 24, 26-30, 32, 34, 35, and 40-49 have not been amended.

Examiner's comments to Section 4A of Applicant's response of August 12, 2008

In section 6 of the Final Action dated November 4, 2008 the Examiner answers to Applicant's argument on the issue that Cristiano is non-analogous art by citing *In re Oetiker* and by stating that a prior art reference, in order to be correctly cited, just needs to be "reasonably pertinent to the particular problem with which the applicant was concerned." According to the Examiner, Cristiano is "reasonably pertinent" because is directed to the problem of "transmitting motion from a piston to another element."

Applicant would like to start by noting that Cristiano deals with a stapling mechanism, not a surgical tool. In the same *In re Oetiker* case cited by the Examiner, right after the passage mentioned by the Examiner and as a limiting statement to such passage, it was also noted that "[t]he combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." A copy of *In re Oetiker* can be found, for example, at <http://www.altlaw.org/v1/cases/411839>.

This means that the Examiner should look at Bent when trying to find such reason, suggestion or motivation. When addressing Bent, the Examiner notes that Bent does not specifically teach a motion transmission member that is a lever. Such statement is not a reason, suggestion or motivation. Moreover, the Examiner states that "substitution of one motion transmission member for another would have yielded predictable results, namely to transfer movement from the piston to another element." Also this statement is not a reason, suggestion or motivation to combine

Bent with Cristiano. On the other hand, it is a suggestion not to combine them given that, according to the Examiner, transmission of motion is already obtained in Bent.

Examiner's comments to Section 4B of Applicant's response of August 12, 2008

In section 7 of the Final Action dated November 4, 2008, the Examiner answers to Applicant's argument on the issue of element 100 in Bent, by stating that "[t]he motion of 104 is being transmitted through 100 to the blade, therefore 100 is a motion transmission member."

Applicant respectfully submits that the Examiner's statement is incorrect. The language of claim 1 recites that "[the] piston is coupled to [the] slidable blade by interposition of a motion transmission member." Given that Applicant's "piston" is, according to the Examiner, element 104 in Bent, the Examiner should note that element 100 in Bent (which is also a piston) is not interposed between Bent's piston 104 and Bent's blades and does not transmit the movement of piston 104 to the blades. Reference can be made, for example, to Figure 3 and column 6, lines 41-46 in Bent: "Gas pressure . . . will . . . urge piston 100 . . . and the forces thus generated coupled with the forces exerted . . . against piston 104 will combine to urge piston assembly 82 forwardly . . . " In other words, the action of pistons 100 and 104 is a joint action, occurring at the same time, and the movement of piston 100 is by no means a consequence of the movement of piston 104. The output pressure of piston 104 is not used as an input for piston 100. Although Bent talks about "coupling" of the pistons 100 and 104, such coupling is by juxtaposition and not by "*interposition*" as recited in Applicant's claim 1.

Examiner's comments to Section 4C of Applicant's response of August 12, 2008

In section 8 of the Final Action dated November 4, 2008 the Examiner answers to Applicant's argument on the issue of presence/absence of a hint on how a substitution in Bent should be done. In particular, the Examiner recites language taken from MPEP 2145 III ("Arguing That Prior Art Devices Are Not Physically Combinable"). While Applicant understands the point of the Examiner, Applicant notes that Applicant's contention was different. In other words: Bent teaches two pistons operating in parallel (see also paragraph above), while Cristiano teaches a piston and a lever operating in series. Given that the *In re Keller* case mentioned by the

Examiner talks about “combining” the teaching of references, such combination would bring to three pistons and a lever, which is not what is claimed.

Moreover, the Examiner is invited to give a look at the MPEP section 2145 III the Examiner is relying on in section 8 of the Final Action. That section ends with the sentence “However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01.” which is exactly the rationale of Applicant’s section 4C of the response of August 11, 2008. Applicant has even put the wording “MPEP 2143.01” in parentheses immediately after the title “4C” given to that section!

In other words, even following the Examiner’s reasoning that lever 16 of Cristiano would replace piston 100 of Bent, such change would clearly render Bent inoperable for its purpose. As mentioned in the above cited passage at column 6, lines 41-46 of Bent, the forward movement (right-to-left in Figure 3 of Bent) of Bent’s pistons 100 and 104 is a consequence of gas pressure exercised in chambers 130, 94 and 96 (see again Figure 3 in Bent). If Bent’s lever 16 is put in place of piston 100, such lever could only be attached to piston 104 but then it would be impossible to obtain a horizontal movement in the right-to-left direction that causes horizontal movement of the piston assembly 82 below pistons 100 and 104.

Examiner’s comments to Section 4D of Applicant’s response of August 12, 2008

In section 9 of the Final Action dated November 4, 2008 the Examiner answers to Applicant’s arguments by noting Applicant’s use of terms not in the claims. Applicant’s point was that Applicant’s “lever” is *“rotatably connected at opposed ends thereof to [the] . . . blade and to the stem of [the] piston.”* Where does the combination Bent + Cristiano teach such limitation?

Examiner’s comments at page 3 of the Final Action

Applicant takes this opportunity to thank the Examiner for the additional comments at page 3 of the Final Action of November 4, 2008. Applicant will now present arguments as to why, the combination of elements of claim 1 of the present application a) is not a simple substitution to a

piece of prior art ready for improvement and b) is uniquely challenging or difficult for one of ordinary skill in the art.

a) The “substitution” to be made to Bent is not “simple”, because Bent’s pistons 100 and 104 operate at the same time and the movement of one is not the consequence of the movement of the other, given that they both move as a consequence of gas pressure. On the other hand, the “*lever*” of Applicant’s claim 1 has to be “*interposed*” between the “*motion transmission member*” and the “*slidable blade*.” Moreover, Bent is not “ready for such improvement”, given that replacement of piston 100 with Cristiano’s lever would render Bent inoperable for its purpose, as already mentioned above.

b) Such “substitution”, if made, would require a complete rearrangement of Bent, as seen by what shown in Figure 3 of Bent, where pistons 100 and 104 operate to move in a horizontal direction to consequently move another assembly (piston 82) in a horizontal direction as well. On the other hand, Cristiano’s lever 16 transforms, through cooperation with a pawl 14, an inclined movement of piston 86 into a vertical movement of plunger 56. Therefore, it would be uniquely challenging, for the person skilled in the art, to replace a horizontally moving “cause” (100 and 104 in Bent) producing a horizontally moving “effect” (82 in Bent) with an inclinedly moving “cause” (86 in Cristiano) producing a vertically moving “effect” (56 in Cristiano).

Conclusions

In view of the above arguments, reconsideration and allowance of all the claims are respectfully requested

Fees

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-4194. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection herewith may be charged to deposit account no. 50-4194.

I hereby certify that this correspondence
is being electronically transmitted on

December 31, 2008
(date of deposit)
/Alessandro Steinfl/

(signature of person transmitting)

Respectfully submitted,

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